

## REMARKS

### I. Introduction

With the addition of claims 37 to 42, claims 15 and 18 to 42 are pending in the present application. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are allowable and reconsideration is respectfully requested.

### II. Rejection of Claims 15, 18, 23 and 28 to 31 Under 35 U.S.C. § 103(a)

Claims 15, 18, 23 and 28 to 31 were rejected under 35 U.S.C. § 103(a) as unpatentable over United States Patent No. 6,473,609 ("Schwartz") in view of United States Patent No. 6,088,594 ("Kingdon"). Applicants respectfully submit that this rejection should be withdrawn for the following reasons.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Claim 15 relates to a method for transmitting messages between at least one main station and a terminal via a telecommunications network, which method includes providing a matching device between the at least one main station and the terminal, controlling a message exchange using the matching device in dependence upon at least one input from the terminal or the at least one main station, and matching, by the matching device, at least one characteristic for transmission of the message to the at least one input, wherein the at least one characteristic is a data type, a data format and/or a transmission mode. Claim 15 further recites that **the entire message is transmitted in a transmission format that is determined in dependence upon a transmission format request made by the terminal or the at least one main station.**

Schwartz relates to a navigation of the Internet by two-way interactive communication mobile devices that are capable of wireless communication on the Internet via a link server with service providers or network servers. (See Schwartz, Abstract.) As admitted on page 5 of the Office Action, Schwartz does not disclose a message transmitted between a terminal and at least one main station in a **format that is determined in dependence upon a format request made by the terminal or the at least one main station**.

Kingdon relates to a telecommunications system and method, which involves a terminal-based browser within a mobile station that connects to web-based location services via a mobile positioning center, so that a graphical presentation of the current location of the mobile station may be displayed thereon in a manner selected by the mobile subscriber. (See Kingdon, Abstract). In this regard, it is respectfully submitted that Kingdon does not disclose a message transmitted between the mobile station and the mobile positioning center in a **transmission format that is determined in dependence upon a transmission format request made by the mobile station or the mobile positioning center**. It is asserted on page 5 of the Office Action that the Abstract and col. 4, lines 9 to 55 of Kingdon disclose a message transmitted in a format that is determined in dependence upon a format request made by a terminal or at least one main station. However, this cited portion of Kingdon only concerns the content of the message, **rather than its transmission format**. In particular, the format request sent between the mobile station and the mobile position center merely determines the format of the returned location information (e.g., a street address or a location on a map) contained in the message, **but not the transmission format of the entire message**. Hence, such a format request does not relate to at least one characteristic for transmission of the message, as required by claim 15. Although Kingdon purports to support the transmission of complex responses involving, for example, bit-mapped graphics, such complex transmission has nothing to do with the format request. Instead, the format request is merely used to determine which location information is to be transmitted, i.e., whether, for example, the street address or a location on a map is to be sent. (See Kingdon, col. 4, lines 46 to 50). Indeed, the data type used for the transmission or the data format of the bit-map graphics used for the transmission is not requested by the mobile station, but instead is made available via a web-based application 330 and the WAP protocol so that the format used for transmission is adapted automatically to the mobile station, and therefore **not determined in dependence upon the transmission format request**, as required by claim 15. Accordingly,

for at least these reasons, it is respectfully submitted that the features of claim 15 discussed above are not in any way disclosed or suggested by the combination of the Schwartz and the Kingdon references.

It is also respectfully submitted that a person having ordinary skill in the art would not be motivated to modify Schwartz in view of the Kingdon reference in an attempt to arrive at the claimed invention of the present application, because the **automatic format adaption** for data transmission disclosed in Kingdon teaches away from the claimed subject matter of the present application, i.e., a request regarding the format used for transmission cannot be achieved. Moreover, even if there were some motivation to combine the teachings of the applied references, which motivation does not exist, the resulting system would still not include the features of claim 15 discussed above.

Accordingly, it is respectfully submitted that claim 15 is allowable for all of the above reasons. Also, since claim 29 recites features analogous to claim 15 and since claims 18, 23 and 28 depend from claim 15, it is respectfully submitted that these claims are allowable for the same reasons that claim 15 is allowable.

Regarding claim 30 and 31, these claims recite a method and a device, respectively, for transmitting messages between at least two main stations. The Examiner concedes on page 9 of the Office Action that Schwartz does not disclose at least two main stations, but the Examiner asserts that Kingdon discloses at least two main stations, i.e., “Kingdon discuss[es] connect[ing] a mobile to one [or] more servers on the internet via the internet addresses,” at col. 4, lines 38 to 45. Applicants respectfully disagree with this assertion, since col. 4, lines 38 to 45 of Kingdon merely state that the TCP/IP suite of protocols is used to establish a connection between the mobile station 200 and the web-based location application 300, and that, in general, the TCP/IP protocol suite defines the address of **all nodes on the Internet**. In this regard, the term “nodes” is used in a general sense to refer to all elements of the Internet responsible for routing of packets therein, such as, for example, a switching exchange element, and the term “nodes” in no way implies the disclosure of a **plurality of main stations**, as recited in claims 30 and 31. Indeed, Kingdon makes reference to the establishment of only a single TCP/IP connection, which by definition, cannot support more than one main station. It is also respectfully submitted that the “nodes on the internet (320)” referred to in column 4, line 44, of Kingdon are not main stations as recited in claims 30 and 31 for the further reason that these “nodes” lie in the transmission path between the

terminal (200) and the application (330), the application (330) being the only device asserted by the Examiner as being equivalent to a matching device.

For the foregoing reasons, Schwartz and Kingdon, either individually or in combination, fail to disclose, or even suggest, a method or a device for transmitting messages between at least two main stations, as recited in claims 30 and 31. It is therefore respectfully submitted that it would not have been obvious to modify the invention of Schwartz as suggested because Kingdon does not disclose, or even suggest, at least two main stations. Furthermore, even if there were some motivation to combine the applied references, the resulting combination would not provide the claimed invention of claims 30 and 31. Accordingly, for at least these reasons, it is respectfully submitted that claims 30 and 31 are allowable.

In view of the foregoing, it is respectfully requested that the obviousness rejection of claims 15, 18, 23, and 28 to 31 be withdrawn.

### **III. Rejection of Claims 19, 20 and 22 Under 35 U.S.C. § 103(a)**

Claims 19, 20 and 22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Schwartz in view of Kingdon and in further view of United States Patent No. 6,138,158 ("Boyle").

It is respectfully submitted that even if it were proper to combine the references as suggested (which is not conceded by Applicants), the secondary Boyle reference does not cure the critical deficiencies of the Schwartz and Kingdon references (as explained above) with respect to parent claim 15, from which claims 19, 20 and 22 depend. Indeed, the Office Action does not allege that Boyle cures the critical deficiencies of the primary references as applied against parent claim 15. It is therefore respectfully submitted that claims 19, 20 and 22 are allowable for at least the same reasons that claim 15 is allowable. Accordingly, withdrawal of the obviousness rejection of claims 19, 20 and 22 is respectfully requested.

### **IV. Rejection of Claim 21 Under 35 U.S.C. § 103(a)**

Claim 21 was rejected under 35 U.S.C. § 103(a) as being unpatentable over United States Patent No. 6,473,609 ("Schwartz '609") in view of Kingdon and in further view of United States Patent No. 6,243,739 ("Schwartz '739").

It is respectfully submitted that even if it were proper to combine the references as suggested (which is not conceded by Applicants), the secondary Schwartz '739 reference does not cure the critical deficiencies of the Schwartz '609 and Kingdon references (as explained above) with respect to claim 15, from which claim 21 depends. Indeed, the Office Action does not allege that Schwartz '739 cures the critical deficiencies of the primary references as applied against parent claim 15. It is therefore respectfully submitted that claim 21 is allowable for at least the same reasons that claim 15 is allowable. Accordingly, withdrawal of the obviousness rejections of claim 21 is respectfully requested.

**V. Rejection of Claims 24 to 27 Under 35 U.S.C. § 103(a)**

Claims 24 to 27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Schwartz in view of Kingdon and in further view of United States Patent No. 6,560,640 ("Smethers").

It is respectfully submitted that even if it were proper to combine the references as suggested (which is not conceded by Applicants), the secondary Smethers reference does not cure the critical deficiencies of the Schwartz and Kingdon references (as explained above) with respect to claim 15, from which claims 24 to 27 ultimately depend. Indeed, the Office Action does not allege that Smethers cures the critical deficiencies of the primary references as applied against parent claim 15. It is therefore respectfully submitted that claims 24 to 27 are allowable for at least the same reasons that claim 15 is allowable. Accordingly, withdrawal of the obviousness rejections of claims 24 to 27 is respectfully requested.

**VI. Rejection of Claims 32 to 36 Under 35 U.S.C. § 103(a)**

Claims 32 to 36 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Schwartz in view of Kingdon and in further view of United States Patent No. 6,730,389 ("Isomursu").

It is respectfully submitted that even if it were proper to combine the references as suggested (which is not conceded by Applicants), the secondary Isomursu reference does not cure the critical deficiencies of the Schwartz and Kingdon references (as explained above) with respect to claim 15, from which claims 32 to 36 depend. Indeed, the Office Action does not allege that Isomursu cures the critical deficiencies of the primary references as applied against parent claim 15. It is therefore respectfully submitted that

claims 32 to 36 are allowable for at least the same reasons that claim 15 is allowable. Accordingly, withdrawal of the obviousness rejections of claims 32 to 36 is respectfully requested.

**VII. New Claims 37 to 42**

New independent claims 37 to 42 do not add any new matter and are allowable for at least the following reasons.

New independent claim 37 recites a method for transmitting messages between different main stations and at least one terminal via a telecommunications network, the different main stations offering different services. To this end, the exchange of messages is controlled by a matching device between the main stations and the terminal as a function of at least one input of the terminal. In the direction of transmission from the main stations to the terminal, the matching device transmits the various services matched into a uniform service according to the at least one input of the terminal. Support for these recited features of claim 37 is found, for example, on page 8, line 29 to page 9, line 6 of the Substitute Specification.

It is respectfully submitted that claim 37 recites features not disclosed, or even suggested, by the cited references. For example, claim 37 defines different main stations that offer different services, which represents a clear difference from the Internet nodes disclosed in column 4, line 44 of Kingdon. The Internet nodes are not service providers, who offer different services, but are merely terminal points in the switching technology of a connection, between which nodes (according to column 4, line 45) data packets are sent. Nor are the “web-based location applications” (mentioned in column 3, line 33) equivalent to main stations as recited in claim 37, as can be seen from Figure 3 of Kingdon. According to column 4, lines 48 through 50 of Kingdon, it is the application (330) which converts location information from the mobile positioning centre (270) into the format requested by the terminal, but here, the “nodes on the internet (320)” referred to in column 4, line 44, of Kingdon are not main stations as recited in claim 37 for at least the reason that these “nodes” of Kingdon lie in the transmission path between the terminal (200) and the application (330), the application (330) being the only device asserted by the Examiner as being equivalent to a matching device.

It is also respectfully submitted that Kingdon does not disclose the recited features of claim 37, according to which, in the direction of transmission from the main stations to the terminal, the matching device transmits the various services matched into a uniform service according to the at least one input of the terminal. In Kingdon, the mobile station requests a particular format from the application (330), e.g., street address, location on a map, etc. According to column 5, lines 39 through 45 of Kingdon, the mobile positioning centre (270) provides the geographical position of the mobile station to the application (330), which converts the information provided by the mobile positioning centre (270) into the desired format and sends it to the terminal (200). Such a format conversion, however, is distinguishable from the unification of different services of different main stations, as recited in claim 37, in which the terminal is provided with the option, in the event that different main stations offer different services, of specifying a uniform service for the transmission from the matching device to the terminal such that those services of those main stations that do not match this specified service must be converted by the matching device into the service requested by the terminal prior to transmission to the terminal. This has the advantage that the matching device allows for a matching of main stations or servers of different services to a terminal without a direct connection between the terminal and the respective main station having to be established and without service-specific protocols, which would therefore differ depending on the main station, having to be transmitted between the terminal and the respective main station.

In view of the foregoing, it is respectfully submitted that claim 37, as well as claim 40, which recites features analogous to claim 37, are allowable over the applied references.

New independent claim 38 recites features analogous to claim 37, except that the different services are not matched to a uniform service in accordance with the at least one input of the terminal, but rather to a uniform transmission mode in accordance with the at least one input of the terminal. In this regard, claim 38 recites that in the direction of transmission from the main stations to the terminal, the matching device matches the various services into a uniform transmission mode according to the at least one input of the terminal. Support for these recited features is found, for example, on page 9, line 24 through page 10, line 27 of the Substitute Specification.

By contrast, Schwartz and Kingdon do not disclose, or even suggest, the recited features of claim 38 because Schwartz and Kingdon do not disclose different main stations that offer different services. As admitted on page 9 of the Office Action, Schwartz does not disclose at least two main stations. In Kingdon only one main station is provided, which offers one service, namely, the mobile positioning centre. A “web-based location applications” is referred to in column 3, line 33 of Kingdon, and “nodes on internet” are disclosed in column 4, line 43 of the Kingdon, which lie between the application (330) and the terminal (200), as shown, for example, from Figure 3. If, as indicated in the Office Action, the “nodes of the internet” were to correspond to the main stations (which is not conceded by Applicants), then, contrary to Figure 3 of Kingdon, the web-based applications (330) would have to lie between the Internet (320) and the terminal (200), which they do not.

In view of the foregoing, it is respectfully submitted that claim 38, as well as claim 41, which recites features analogous to claim 38, are allowable over the applied references.

New independent claim 39 recites a method for transmitting messages between at least one main station and at least one terminal via a telecommunications network, the exchange of messages being controlled by a matching device between the at least one main station and the terminal as a function of at least one input of the at least one main station, the matching device matching at least one property for the transmission of the message, in particular the data type, the data format or the transmission mode, to the at least one input of the at least one main station. It is respectfully submitted that these recited features of claim 39 are not disclosed, or even suggested, by Schwartz or Kingdon.

In view of the foregoing, it is respectfully submitted that claim 39, as well as claim 42, which recites features analogous to claim 39, are allowable over the applied references.

**CONCLUSION**

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

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